

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM L. SCHAEFER and LEROY J. BEALER, JR.

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Appeal No. 1998-0801  
Application No. 08/557,979

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ON BRIEF

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Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 and 13 through 16, which are all of the claims remaining in this application. Claims 1 through 10 and

Appeal No. 1998-0801  
Application No. 08/557,979

12 have been canceled.

As noted on page 1 of the specification, appellants' invention relates to the field of bioremediation of dissolved hydrocarbons in ground water by increasing the amount of dissolved oxygen in the ground water resulting in enhanced biodegradation of the hydrocarbons by aerobic microbes. More specifically, the claims on appeal are directed to a particular apparatus for treating contaminated ground water to achieve the results noted in the above described field of the invention. Independent claim 11 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' substitute brief (Paper No. 14).

The prior art references of record relied upon by the examiner are:

Bernhardt et al. (Bernhardt)	4,950,394	Aug.
		21, 1990
Breslin	5,474,685	Dec. 12,
1995		(filed Feb.
14, 1994)		

Appeal No. 1998-0801  
Application No. 08/557,979

Claims 11 and 13 through 16 stand rejected under 35  
U.S.C.

§ 103 as being unpatentable over Bernhardt in view of Breslin.  
As indicated on page 3 of the answer, it is the examiner's  
opinion that

Bernhardt discloses a well aerator having a float  
and a coiled tube leading to the surface, with a  
means for providing negative pressure in the  
wellhead, substantially as claimed. The instant  
claims differ in certain structural features, such  
as the weight being below the aeration means, having  
the float slidably attached to the tube, and the  
materials of the aerator and the weight. It is well  
known to have a weight be at the bottom of a  
weighted system, as exemplified by Breslin. It is  
submitted that the specific structure and materials  
are matters of design consideration, which would  
have been obvious for one skilled in the art, and  
therefore fail to patentably distinguish over  
Bernhardt.

Rather than reiterate the conflicting viewpoints advanced  
by the examiner and appellants regarding the above-noted  
rejection, we refer to the examiner's answer (Paper No. 15,  
mailed October 24, 1997) and to appellants' substitute brief  
(Paper No. 14, filed October 6, 1997) for a full exposition  
thereof.

OPINION

Having carefully reviewed the obviousness issue raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 will not be sustained. Our reasoning in support of this determination follows.

Even if we were to agree with the examiner that it would have been obvious to one of ordinary skill in the art to provide the apparatus of Bernhardt with a weight fixed at the bottom thereof to provide a weighted system for use in the well shaft (10), we see nothing in the applied references which addresses the additional specific structural features of the claimed subject matter as set forth in claim 11, or in claims 13 through 16 which depend therefrom. Like appellants, we find the examiner's reliance on "design consideration" to provide for the many structural differences between the apparatus of Bernhardt and that defined in the claims on appeal to be entirely untenable, fraught with speculation and conjecture, and completely without any evidential support.

Appeal No. 1998-0801  
Application No. 08/557,979

In this regard, it appears that the examiner has lost sight of the need for the applied references to actually disclose, teach or suggest the recited structural features of appellants' claimed subject matter and for the references to provide some motivation for making the combination thereof so as to result in the claimed subject matter in order to support a rejection based on obviousness under 35 U.S.C. § 103. In this case, we agree with appellants that the references to Bernhardt and Breslin, whether considered alone or in combination, fail to teach or suggest a "tubing means" as claimed, i.e., one having a coiled portion which serves as a spring and, when suspended in a well, "does not extend to said ground water," and further includes an extension that continues below said coiled portion and terminates in said ground water. Moreover, the applied references also do not teach or suggest a "float means" as claimed which is "adapted to be slidably attached to said tubing means below said coiled portion," or an aeration means along with a weight means that is "fixedly attached to the lower end of said tubing means below said aeration means," as set forth in appellants' claim 11 on appeal. The references used by the

Appeal No. 1998-0801  
Application No. 08/557,979

examiner also provide no response whatsoever for the features set forth in dependent claims 13 through 16 on appeal.

It follows from the foregoing that the examiner's rejection of claims 11 and 13 through 16 on appeal under 35 U.S.C. § 103 relying on Bernhardt and Breslin will not be sustained.

The decision of the examiner to reject claims 11 and 13 through 16 under 35 U.S.C. § 103 is, accordingly, reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	APPEALS AND

Appeal No. 1998-0801  
Application No. 08/557,979

	)	
	)	INTERFERENCES
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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